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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,389	12/15/2003	Thomas E. Creamer	BOC9-2003-0088 (459)	6219
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AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER NOONAN, WILLOW W	
			ART UNIT	PAPER NUMBER
			2146	
			MAIL DATE	DELIVERY MODE
			02/11/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/736,389

**Applicant(s)**

CREAMER ET AL.

**Examiner**

Willow Noonan

**Art Unit**

2146

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/19/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The instant application having Application No. 10/736,389 has a total of 24 claims pending in the application; there are 8 independent claims and 16 dependent claims, all of which are ready for examination by the examiner.

#### ***Oath/Declaration***

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in 37 C.F.R. 1.63.

#### ***Drawings***

3. The applicant's drawings submitted are acceptable for examination purposes.

#### ***Information Disclosure Statement***

4. As required by M.P.E.P. 609(C), the applicant's submission of the Information Disclosure Statement dated April 19, 2004 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by M.P.E.P 609 C(2), a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

***Response to Amendment***

5. The declarations filed on 11/21/2007 under 37 CFR 1.131 are sufficient to overcome the Phillips and Guigui references.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The "system" claimed in each of claims 12-18 could be interpreted in a manner consistent with Applicant's specification as solely software. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. A computer program is not clearly a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent App. Pub. No. 2003/0212800) in view of Applicant's admitted prior art (hereafter "AAPA"), Faccin (U.S. Patent App. Pub. No. 2003/0014668), and Pailer ("A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system").

Regarding claims 1, 7, 10, 16, and 19, Jones teaches a method of authenticating a mobile communication device comprising forming a referred by token using authentication data provided by a mobile service provider over a mobile communications link over a mobile communications network. See Jones at p. 2, paragraph 22 ("the subscriber station then sends an authentication request message into the access network, identifying both (i) a designated one of the service provider systems (e.g., a service provider ID, for instance) and (ii) one or more authentication credentials (such as subscriber ID (e.g., user ID or station ID) and password)."). Jones teaches sending the token to an authentication server via a wireless communications link over a wireless network, wherein the authentication server sends a request for validation, built using the token, to the mobile service provider. See Jones at p. 2, paragraph 23 ("the access network then sends the authentication request message

(possibly reformatted or changed in some respect) to the authentication entity of the service provider system designated by the request.”). Jones teaches receiving a reply from the authentication server over the wireless network communications link, wherein the reply indicates whether the request for validation from the authentication server was confirmed. See Jones at p. 2, paragraph 24 (“the authentication entity will send an authentication response message to the access network”).

Jones does not teach that the authentication server is a Session Initiation Protocol (SIP) server or that the request for validation uses Parlay. However, Faccin teaches that it is well known to use SIP for authenticating communication devices in a network. See Faccin at fig. 1. It would have been obvious to one of ordinary skill to use Faccin’s technique in Jones’ system because Faccin teaches that the disclosed technique may be used to authenticate a subscriber in a mobile terminated call. See Faccin at p. 1, paragraph 10. Pailer teaches that it is well known map SIP functionality to Parlay services. See Pailer, *Abstract*. It would have been obvious to use Pailer’s technique in Jones’ system because Pailer teaches that the use of the Parlay APIs may speed up application development and increase interoperability. See Pailer, *Abstract*.

Regarding claims 4, 13, and 22, Jones teaches a method of authenticating a mobile communication device comprising receiving a referred by token from the mobile communication device over a wireless communications link over a wireless network, wherein the token was built using authentication data provided by a mobile service provider received over a mobile communications link over a mobile communications network. See Jones at p. 2, paragraph 22 (“the subscriber station then sends an

authentication request message into the access network, identifying both (i) a designated one of the service provider systems (e.g., a service provider ID, for instance) and (ii) one or more authentication credentials (such as subscriber ID (e.g., user ID or station ID) and password).”). Jones teaches interpreting the token, forming a request using data specified by the token, and sending a request for validation of the mobile communication device to the mobile service provider. See Jones at p. 2, paragraph 23 (“the access network then sends the authentication request message (possibly reformatted or changed in some respect) to the authentication entity of the service provider system designated by the request.”). Jones teaches receiving a response from the mobile service provider and sending a reply to the mobile communication device over the wireless network communications link indicating whether the request for validation was confirmed. See Jones at p. 2, paragraph 24 (“the authentication entity will send an authentication response message to the access network”).

Regarding claims 2-3, 5-6, 8-9, 11-12, 14-15, 17-18, 20-21, and 23-24, AAPA teaches that it is well known to use a wireless network that is compliant with at least one of an 802.16, 802.20, or 802.15 wireless communications protocol. See present application at p. 2. Further, Jones teaches that the wireless network is compliant with an 802.11 wireless communications protocol. See Jones at p. 2, paragraph 21.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willow Noonan whose telephone number is (571) 270-

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1322. The examiner can normally be reached on Monday through Friday, 7:30 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JEFFREY PWU  
SUPERVISORY PATENT EXAMINER